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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,627	10/24/2001	Mark A. Hamm	265/221	2532

34313 7590 09/08/2003

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SUITE 1600  
IRVINE, CA 92614-2558

EXAMINER

HYEON, HAE M

ART UNIT	PAPER NUMBER
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2839

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

10/039,627

Applicant(s)

HAMM ET AL.

Examiner

Hae M Hyeon

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 and 22-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.5. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of claims 1-12 and 16-29 of Group 1 in Paper No. 7 and claims 16-21 of the species in Figure 8 in Paper No. 9 are acknowledged.

### ***Drawings***

2. The drawings are objected to because the cross-hatching lines of the cross-sectional views are improper. A specific cross-hatching line should be used in the cross-sectional view to represent a specific type of materials. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The disclosure is objected to because of the following informalities:
  - On page 14, line 7, "shaft 6" should be -- shaft 56 --.
  - On page 14, lines 21-22, "the catheter connector fiber" should be -- the catheter fiber connector --.

Appropriate correction is required.

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 16-22 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: at least two cutouts of the retainer and other elements. Claim 16 recites two cutouts of the retainer, but claims 16-21 do not recite the purpose of the cutouts and their structural relationship with other elements.

7. Claims 16-21 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted element is: the ribs 127 that works with the grip area 126 and the cutout 129 to provide a means for grasping and/or transferring force to the catheter fiber connector 122 to push it into proper engagement with the motor unit.

8. Claim 17 recites the limitation "the openings" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites that the retainer has at least two cutouts, but claim 16 does not recite openings in the retainer. An opening is a specific type of cutouts. Since "cutouts" recited in claim 16 is broader than "openings" recited in claim 17 and claim 17 does not define whether the openings are the cutouts, it is not clear what are the openings.

9. Claim 21 recites the limitation "the other surface" in line 2. There is insufficient antecedent basis for this limitation in the claim.

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The catheter has many surfaces. Therefore, it is not clear exactly what is **the other** surface.

***Allowable Subject Matter***

10. Claims 16-21 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

11. The following is a statement of reasons for the indication of allowable subject matter: In combination with all the limitations recited in the independent claim, all the prior arts do not show an optical catheter connector comprising a rigid retainer having at least two cutouts housed inside a flexible hollow catheter ferrule, an optical fiber positioned along a rotational axis of a fiber connector and a connector bushing attached to the fiber connector housed inside the retainer.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 4,900,303 by Lemelson, US Patent No. 5,010,886 by Passafaro et al., US Patent No. 5,026,367 by Leckrone et al., US Patent No. 5,039,193 by Snow et al., US Patent No. 5,371,814 by Ames et al., and US Patent No. 5,872,879 and US Patent No. 6,263,133 B1 by Hamm.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hae M Hyeon whose telephone number is 703-308-4802. The examiner can normally be reached on Mon.-Fri. (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn D Feild can be reached on 703-308-2710. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

**Any response to this action may be mailed to:**

**Commissioner for Patents**

**P.O. Box 1450**

**Alexandria, VA 22313-1450**

For additional information regarding this new address, which was effective May 1, 2003, *see Correspondence with the United States Patent and Trademark Office*, 68 Fed. Reg. 14332 (March 25, 2003).

**Or Faxed to:**

(703) 308-7722 or 308-7724

(Informal or draft communications should be clearly labeled "PROPOSED" or "DRAFT")

**Hand-delivered responses** should be brought to:

Crystal Plaza 4, Fourth Floor (Receptionist)

2201 South Clark Place, Arlington, Virginia.

Hae M Hyeon

Examiner

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hnh

*hnh*

*Hae Moon Hyeon*